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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,858	04/20/2001	Bruce V. Schwartz	UWP00101	5599

7590 12/30/2004

Mr. Jorden M. Becker
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EXAMINER

VAUGHN JR, WILLIAM C

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 12/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/839,858

Applicant(s)

SCHWARTZ ET AL.

Examin r

William C. Vaughn, Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-33 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

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DETAILED ACTION

1. This Action is in regards to the Amendment and Response received on 13 August 2004.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davani, U.S. Patent No. 6,208,839 in view of Spaur et al. (Spaur), U.S. Patent No. 5,732,074.

4. Regarding **independent claims 1, 6, 11 and 21** (e.g., exemplary independent claim 1), Davani discloses the invention substantially as claimed. Davani discloses *a system for reducing perceived latency in servicing user requests for unsolicited information made from remote devices, the system comprising a computer to (a) receive the unsolicited information and an identification of an intended recipient of the unsolicited information, wherein the unsolicited information is received according to a first transmission protocol in a first form [see Davani, Col. 2, lines 25-47], and (b) in response to the receipt of the unsolicited information and recipient identification, to cause the computer: (1) to generate a plurality of message entities that convey at least a portion of the contents of the unsolicited information in a second form that differs from the first form [see Davani, Col. 2, lines 35-67 and Col. 3, lines 1-7], (Davani teaches a paging protocol), [see Davani, Col. 4, lines 7-35], (3) to send a notification so as to be received by the respective remote device, wherein the notification indicates the plurality of*

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message entities have been previously sent to the respective remote device [see Davani, Col. 2, lines 54-67]. However, Davani does not explicitly disclose to send the message entities according to a second transmission protocol that differs from that the message entities have been previously been sent.

5. In the same field of endeavor, Spaur discloses (e.g., mobile portable wireless communication system). Spaur discloses *to send the message entities via the transmitter according to a second transmission protocol that differs from the first transmission protocol so as to be received by a respective remote device associated with the intended recipient, wherein the second transmission protocol is optimized for use with a wireless device* [see Spaur, item 102, 'Col. 5, lines 40-67, Col. 6, lines 1-66 and Col. 8, lines 24-65].

6. Accordingly, it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have incorporated Spaur's teachings of a mobile portable wireless communication system with the teachings of Davani, for the purpose of providing processing capability that involves protocols of a variety and a large number of users [see Spaur, Col. 2, lines 1-8]. By this rationale independent claim 1 is rejected.

7. Regarding **claim 2**, Davani-Spaur discloses *wherein the message entities in the second form preserve the order of the unsolicited information in the first form* [see Davani, item 306]. By this rationale **claim 2** is rejected.

8. Regarding **claim 3**, Davani-Spaur discloses wherein the first transmission protocol conforms to a hypertext transfer protocol [see rejection of claim 1, above] and the second transmission protocol conforms to a handheld device transfer protocol [see rejection of claim 1,

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above]. The same motivation that was utilized in claim 1 applies equally as well to claim 3. By this rationale **claim 3** is rejected.

9. Regarding **claim 4**, Davani-Spaur discloses wherein the first form conforms to a first (hypertext) markup language specification and the second form conforms to a second (handheld device) markup language [The Examiner takes Official Notice [see MPEP 2144.03]]. The motivation that was utilized in claim 1 applies equally as well to claim 4. By this rationale **claim 4** is rejected.

10. Regarding **claim 5**, Davani-Spaur discloses *wherein the first program causes the computer to: determine type of content conveyed by the message entities, check whether the type of content is acceptable to the respective remote device, and if not acceptable, convert the content into another type before sending it to the respective remote device* [see Spaur, Col. 5, lines 41-67 and Col. 1-67]. The motivation that was utilized in claim 1, applies equally as well to claim 5. By this rationale **claim 5** is rejected.

11. Regarding **claim 6**, the limitations of this are substantially the same as that of claim 1, and thus is rejected for the same rationale in rejecting claim 1 above. However, with regards to a hypermedia server, [The Examiner takes Official Notice [see MPEP 2144.03], that it would have been obvious to one of ordinary skill in the networking art at the time the invention was made for Davani to have included a Hypermedia server, for the purpose of providing a system that allows for

12. Regarding **claims 7 and 8**, the limitations of these claims are substantially the same as that of claim 5, and thus are rejected for the same rationale in rejecting claim 5 above.

Furthermore, with *regards to wherein a respective card includes access control information*

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that indicates whether information conveyed in the respective card has access restricted to specific decks [The Examiner takes Official Notice [see MPEP 2144.03]].

13. Regarding **claim 9**, Davani-Spaurs discloses *a system according to claim 6 wherein the deck has a unique identifier in the form of a Uniform Resource Locator (URL)* [see Davani, Col. 7, lines 17-23]. By this rationale **claim 9** is rejected.

14. Regarding **claim 10**, Davani-Spaurs discloses wherein the notification includes a link to a service in any of the remote device, the computer or the hypermedia server that, when invoked, acts on the notification [see rejection of claim 6, supra]. The motivation that was utilized in the combination of claim 1 and 6, applies equally as well to claim 10. By this rationale **claim 10** is rejected.

15. Regarding **claim 11**, the limitations of this are substantially the same as that of claim 1, and thus is rejected for the same rationale in rejecting claim 1 above. Furthermore, with regards *to build a get-request to send to the hypermedia server, wherein the get-request includes one or more parameters from each of the set of session parameters and the set of request parameters* [The Examiner takes Official Notice [see MPEP 2144.03]].

16. Regarding **claim 12**, Davani-Spaurs discloses *wherein the first program causes the computer to: detect a conflict between a parameter in the set of session parameters and a parameter in the set of request parameters, and include a parameter in the get request that represents a resolution of the conflict in favor of the parameter in the set of request parameters* [The Examiner takes Official Notice [see MPEP 2144.03]]. By this rationale **claim 12** is rejected.

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17. Regarding **claims 13 and 14**, Davani-Spaur discloses *wherein the first program causes the computer to establish a set of common parameters that are shared by multiple users and sessions* [see rejection of claim 12, above]. By this rationale **claims 13 and 14** are rejected.

18. Regarding **claims 15 and 16**, Davani-Spaur discloses *wherein the respective remote device is a wireless telephone* [see Davani, items 118, 120, 121, 122]. By this rationale **claim 16** is rejected.

19. Regarding **claim 17**, Davani-Spaur discloses *wherein the respective remote device is a handheld device* [see Davani, items 118, 121, 122]. By this rationale **claim 17** is rejected.

20. Regarding **claim 18**, Davani-Spaur discloses *wherein the second program causes the remote device to store the notification in persistent storage, and to display a list of notifications that have been received by the remote device* [see Davani, Figure 2]. By this rationale **claim 18** is rejected.

21. Regarding **claim 19**, Davani-Spaur discloses *wherein the second program causes the remote device to display an indication of which notifications in the list have been acted upon by an operator of the remote device* [see Davani, Col. 8, lines 18-27]. By this rationale **claim 19** is rejected.

22. Regarding **claim 20**, Davani-Spaur discloses *wherein the second program causes the remote device to determine whether a received notification is a duplicate of another notification already stored* [The Examiner takes Official Notice [see MPEP 2144.03], that it would have been obvious to one of ordinary skill in the networking art at the time the invention was made to have included notification], [See prior art of record, U.S. Patent No. 6,594,481, regarding duplicate notifications, Col. 28, lines 10-15]. By this rationale **claim 20** is rejected.

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23. Regarding claims 21-33, the limitations of these claims are substantially the same as that of claims 1-11, and thus are rejected for the same rationale in rejecting claims 1-11 above.

Double Patenting

24. Claim(s) 1-46 of U.S. Patent No. 6,243,739 contain(s) every element of claim(s) 1-33 of instant U.S. Patent Application No. 09/839,858 and as such anticipate(s) claim(s) 1-33 of the instant application.

25. "A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Response to Arguments

26. Applicant's Request for Reconsideration filed on 13 August 2004 has been carefully considered but is not deemed fully persuasive. However, because there exists the likelihood of future presentation of this argument, the Examiner thinks that it is prudent to address Applicants' main points of contention.

- A. Applicant argues that none of the claims can be subject to statutory double patenting.
- B. Applicant further argues that Spaur does not disclose a notification to indicate that a plurality of message entities have previously been sent.
- C. Applicant contends that Spaur does not disclose transmitting information as a card or deck.
- D. Applicant asserts that neither Davani nor Spaur discuss building a get-request.

27. As to "Point A" of applicant's arguments regarding statutory double patenting. The double patenting rejection is not a statutory double rejection but it is based upon anticipation. Applicant's arguments as well as the amendment have not overcome the double patenting rejection. Every element within the instant application is within the U.S. Patent

28. As to "Point B", it is the position of the Examiner that it is obvious that if a notification regarding specific message entities have been sent that it would include previous messages that where sent.

29. As to "Point C", it is the position of the Examiner that web pages would be equivalent to the a card of information and thus Davani-Spaur does disclose this feature.

30. As to "Point D", it is the position of the Examiner that Davani-Spaur does disclose building a get request, since the utilizing of a web browser that builds HTTP get request in order to send out to a HTTP or internet server to access information on the World Wide Web.

Conclusion

31. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

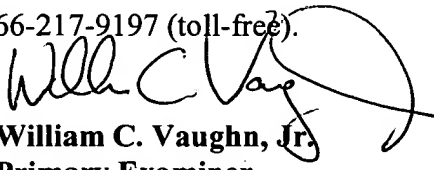
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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William C. Vaughn, Jr. whose telephone number is (571) 272-3922. The examiner can normally be reached on 8:00-6:00, 1st and 2nd Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


William C. Vaughn, Jr.
Primary Examiner
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